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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/764,383 | 01/19/2001 | Simon Shamoun | 2000-1430-RA | 7670 |

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| EXAMINER |
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PASS, NATALIE

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| ART UNIT | PAPER NUMBER |
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3626

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,383

Applicant(s)

SHAMOUN, SIMON

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 24 November 2004. Claims 1, 5, 24, 32-34, 38-39 have been amended. Claims 1-40 remain pending.

Claim Rejections - 35 USC § 112

2. The rejection of claim 32 under 35 U.S.C. 112, second paragraph, for being indefinite, is hereby withdrawn due to the amendment filed 24 November 2004.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 8-10, 14, 16, 33-40 are rejected under 35 U.S.C. 102(b) as being as being anticipated by Mansfield et al, U.S. Patent Number 5, 819, 735 for substantially the same reasons applied in the previous Office Action. Further reasons appear below.

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(A) Claim 1 has been amended to recite

- "printed on a package label, wherein said machine reading inputs nutritional information into said portable nutritional data device," in lines 8-10.

As per these new limitations, Mansfield teaches a portable nutritional data device wherein "the name of the product as well as the serving size that is given on the nutrition facts label will be shown on display 28" (reads on the machine-readable indicia represents nutritional information printed on a package label, wherein said machine reading inputs nutritional information into said portable nutritional data device) (Mansfield; Figure 2, item 28, Figure 3C, column 9, lines 3-5, column 11, lines 52-53).

The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper number 08202004, section 5, page 3), and incorporated herein.

(B) Claim 33 has been amended to recite, "printed on a product package" in line 11.

As per these new limitations, Mansfield teaches a portable nutritional data device wherein the machine-readable indicia is "barcode sorted product nutrition facts found on Nutrition Facts labels of commercial food products" (reads on Nutritional Facts Data printed on a product package) (Mansfield; Figure 2, item 28, Figure 3C, column 9, lines 3-5, column 11, lines 52-53).

The remainder of claim 33 is rejected for the same reasons given in the prior Office Action (paper number 08202004, section 5, pages 4-5), and incorporated herein.

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(C) Claim 34 has been amended to recite, "into a digital medium" in line 5.

As per these new limitations, Mansfield teaches a method of portable nutritional monitoring wherein said machine reading of said indicia inputs nutritional information into a digital medium (Mansfield; see at least Abstract, column 3, line 62 to column 4, line 10, column 6, lines 44-50).

The remainder of claim 34 is rejected for the same reasons given in the prior Office Action (paper number 08202004, section 5, pages 5-6), and incorporated herein.

(D) Claims 38-39 have been amended to recite

- printed on a package label" and "containing nutrition facts data" in lines 3 and 3 respectively.

As per these new limitations, Mansfield teaches a method of portable nutritional monitoring as analyzed and discussed in claim 34 above,

wherein "the name of the product as well as the serving size that is given on the nutrition facts label will be shown on display 28" (reads on said machine readable indicia is the Nutritional Facts Data printed on a product label) (Mansfield; Figure 2, item 28, Figure 3C, column 9, lines 3-5, column 11, lines 52-53); and

wherein said machine readable indicia is "barcode sorted product nutrition facts found on Nutrition Facts labels of commercial food products" (reads on a bar code containing nutrition facts data) (Mansfield; Figure 2, item 28, Figure 3C, column 9, lines 3-5, column 11, lines 52-53).

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The remainder of claims 38-39 is rejected for the same reasons given in the prior Office Action (paper number 08202004, section 5, pages 6-7), and incorporated herein.

(E) Claims 2-4, 8-10, 14, 16, 35-37, 40 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 08202004, section 5, pages 3-7), and incorporated herein.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 24, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansfield et al, U.S. Patent Number 5, 819, 735 as applied to claim 1 above, and further in view of Shepley, U.S. Patent Number 6, 024, 281 for substantially the same reasons applied in the previous Office Action. Further reasons appear below.

(A) The amendments to claim 5 and 24 appear to have been made merely to correct minor typographical or grammatical errors and to correct the language rendering the claims indefinite. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the

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manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 08202004, section 7, pages 7-8), and incorporated herein.

(B) Claim 29 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 08202004, section 7, page 8), and incorporated herein.

7. Claims 6-7, 11-13, 17, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansfield et al, U.S. Patent Number 5, 819, 735 as applied to claim 1 above, and further in view of Brown, U.S. Patent Number 6, 618, 062 for substantially the same reasons applied in the previous Office Action. Further reasons appear below.

(A) Claim 32 has been amended to recite

- "device for entering data on a computer surface " in line 3.

As per these new limitations, Mansfield and Brown teach a portable nutritional data device as analyzed and discussed in claim 1 above,

wherein said means for inputting data is a stylus, a well-known input device for inputting data into a personal digital assistant (reads on stylus device for entering data on a computer surface) (Brown; column 3, lines 23-36).

The remainder of claim 32 is rejected for the same reasons given in the prior Office Action (paper number 08202004, section 8, pages 9-10) and incorporated herein.

The motivations for combining the respective teachings of Mansfield and Brown are as given in the rejection of claim 5 in the prior Office Action (paper number 08202004) and incorporated herein.

(B) Claims 6-7, 11-13, 17 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 08202004, section 8, pages 9-10), and incorporated herein.

8. Claims 15, 18-23, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansfield et al, U.S. Patent Number 5, 819, 735 as applied to claim 1 above, and further in view of Diaz et al, U.S. Patent Number 5, 890, 128 for substantially the same reasons applied in the previous Office Action. Further reasons appear below.

(A) Claims 15, 18-23, 27-28 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 08202004, section 9, pages 10-12), and incorporated herein.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mansfield et al, U.S. Patent Number 5, 819, 735 and Diaz et al, U.S. Patent Number 5, 890, 128 as applied to claim 22 above, and further in view of. Shepley, U.S. Patent Number 6, 024, 281 for

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substantially the same reasons applied in the previous Office Action. Further reasons appear below.

(A) Claim 25 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 08202004, section 10, pages 12-13), and incorporated herein.

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mansfield et al, U.S. Patent Number 5, 819, 735 and Diaz et al, U.S. Patent Number 5, 890, 128 as applied to claim 22 above, and further in view of. Kocher, U.S. Patent Number 6, 652, 455 for substantially the same reasons applied in the previous Office Action. Further reasons appear below.

(A) Claim 26 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 08202004, section 11, pages 13-14), and incorporated herein.

11. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansfield et al, U.S. Patent Number 5, 819, 735 and Shepley, U.S. Patent Number 6, 024, 281 as applied to claim 29 above, and further in view of. Mault et al, U.S. Patent Number 6, 513, 532 for substantially the same reasons applied in the previous Office Action. Further reasons appear below.

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(A) Claims 30-31 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 08202004, section 12, pages 14-15), and incorporated herein.

Response to Arguments

12. Applicant's arguments filed 24 November 2004 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses filed 24 November 2004.

(A) At pages 10-11 of the 24 November 2004, Applicant argues that the limitations of claims 1-4, 8-10, 14, 16, 33-40 are not taught or suggested by the applied reference. In response, all of the limitations which Applicant disputes are missing in the applied reference, including the newly added limitations, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of Mansfield, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 102 and 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 08202004), and incorporated herein.

With respect to Applicant's argument at the paragraph bridging pages 10-11 of the 24 November 2004 response that the applied reference fails to "utilize, anticipate, teach or render obvious a device" wherein "the machine-readable indicia represents nutritional information printed on a package label, wherein said machine reading inputs nutritional information into said

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portable nutritional data device" as recited in newly amended claim 1 and "wherein the machine-readable indicia is the commonly available Nutritional facts Data" as recited in original claim 2, it is respectfully submitted that Applicant ignores the clear and unmistakable teachings of Mansfield with respect to providing "barcode sorted product nutrition facts found on Nutrition Facts labels of commercial food products" and "the name of the product as well as the serving size that is given on the nutrition facts label will be shown on display 28" (emphasis added) and "[t]hese product records will include serving size and nutrition values related to product barcodes that are input into the device" (emphasis added) (Mansfield; Figure 2, item 28, Figure 3C, column 6, lines 44-49, column 9, lines 3-5, column 11, lines 52-53). Examiner interprets Mansfield's teachings as reading on the above limitations.

With respect to Applicant's argument at the paragraph bridging pages 10-11 of the 24 November 2004 response that the applied reference fails to disclose " a specialized bar code containing nutritional information," Examiner notes that this limitation is not recited in the claims.

With respect to Applicant's arguments at paragraphs 2-3 on page 11 and in the paragraph bridging pages 12-13 of the 24 November 2004 response that the applied reference fails to disclose "WITHOUT NECESSITATING A DATABASE by scanning and interpreting the printed words" and "... direct scanning input of the nutrition information without requiring database searching" and "... without access to a database ..." Examiner notes that these limitations are not recited in the claims.

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At pages 12-13 of the 24 November 2004 response, Applicant argues that the limitations of Applicant's invention are not taught or suggested by the applied references and that a *prima facie* case of obviousness has not been established. Examiner respectfully disagrees. In response, all of the limitations which Applicant disputes are missing in the applied reference, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of Mansfield, Shepley, Brown, Diaz, Kocher and Mault , based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 102 and 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 08202004), and incorporated herein.

In addition, The Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. Note, for example, the motivations explicitly stated at lines 8-9 of page 6 of the previous Office Action (paper number 08202004) (i.e., " ... with the motivations of providing a device for providing personalized nutrition information ..."); and at lines 10-14 of page 9 of the previous Office Action (i.e., " ... with the motivations of providing a method for customers to easily attain ... "); and at the

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paragraph bridging pages 10-11 of the previous Office Action (paper number 08202004) (i.e., "... with the motivations of providing a personalized hand held computer with an extensive list of foods and their respective calorie and fat content for review ..."); and at the paragraph bridging pages 12-13 of the previous Office Action (i.e., "... with the motivations of providing a computerized system which can match the nutritional requirements ..."); and at the paragraph bridging pages 13-24 of the previous Office Action (paper number 08202004) (i.e., "... with the motivations of preventing fatalities by providing a device where medicine-to-medicine interactions could be indicated by scanning ...").

Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 08202004)

As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levensgood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Conclusion

13. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. It should be noted that during the month of April 2005, the examiner's phone number will change to (571) 272-6774, however the current phone number will remain in service until the change takes place. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

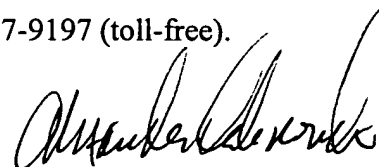
16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. It should be noted that during the month of April 2005, Joseph Thomas' phone number will change to (571) 272-6776, however the current phone number will remain in service until the change takes place. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NP

Natalie A. Pass

February 8, 2005



**ALEXANDER KALINOWSKI
PRIMARY EXAMINER**